

REMARKS

I. Introduction

With the addition of new claim 18, claims 1 to 18 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, Applicants note that the Office Action Summary does not acknowledge the claim for foreign priority and does not indicate receipt of the certified copy of the priority document. The present application claims foreign priority to German Patent Application No. 102 55 442.0, filed on November 28, 2002. A claim for foreign priority to the foregoing application was made, inter alia, in the "Declaration and Power of Attorney," which was filed on March 20, 2004. Applicants respectfully request acknowledgment of the claim for foreign priority and an indication of receipt of the certified copy of the priority document in the next Office communication.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

II. Objections to the Drawings

As regards the objections to the drawings, it is respectfully submitted that the accompanying replacement sheet obviate these objections. In particular, Fig. 2 has been amended without prejudice to eliminate duplicate reference characters. The Specification has also been amended accordingly. No new matter has been added. In view of the foregoing, it is respectfully submitted that these objections have been obviated, and withdrawal of these objections is respectfully requested.

III. Objection to Claim 8

As regards the objection to claim 8, the Examiner will note that claim 8 has been amended herein without prejudice as suggested. Accordingly, withdrawal of this objection is respectfully requested.

AMENDMENTS TO THE DRAWINGS:

The attached one (1) sheet of drawings, which includes Figs. 1 and 2, replaces the original sheet including Figs. 1 and 2. The changes consist of eliminating duplicate reference characters in Fig. 2, and adding reference characters --201--, --202--, --203--, --204--, --205-- and --50-- to Fig. 2. No new matter has been added.

Attachment: One (1) Replacement Sheet

IV. Rejections of Claims 1, 3 to 9 and 13 to 15 Under 35 U.S.C. § 102(b)

Claims 1, 3 to 9 and 13 to 15 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 3,728,919 ("Scott"). It is respectfully submitted that Scott does not anticipate the present claims as amended herein for at least the following reasons.

As an initial matter, claim 6 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 6.

Claim 1 relates to a tool for at least one of cutting and noncutting treatment of a metallic component, the tool including a shank-shaped section including a tool section subject to wear and a cavity, an arrangement configured to admit a pressure medium to the cavity to monitor operability of the tool, and a monitoring device configured to generate a signal in accordance with a pressure change in the pressure medium. Claim 1 has been amended herein without prejudice to recite that the shank-shaped section includes a predetermined breaking point. Support for this amendment may be found, for example, in claim 6 as originally filed.

In contrast, Scott purports to relate to a machine tool to sense breakage of a punch 13 by detecting pressure changes which occur in a pneumatic circuit 17 as a result of the punch 13 breaking. See, col. 1, lines 4 to 9. Scott, however, makes no mention of a predetermined breaking point. The punch 13 is provided with a small cylindrical passageway 27 drilled axially through the punch 13 so that when the punch 13 is broken, such as shown in Figure 3, the passageway 27 is opened thereby permitting the pressurized air to escape from the circuit 17. As plainly illustrated in Figure 3, the punch 13 is not broken at a predetermined breaking point.. Indeed, there is no mention whatsoever by Scott of a predetermined breaking point. Accordingly, Scott does not in any manner identically disclose, or even suggest, a tool having a shank-shaped section that includes a predetermined breaking point, as recited in claim 1. Accordingly, it is respectfully submitted that Scott does not anticipate claim 1.

As regards to claims 3 to 5, 7 to 9 and 14, which depend from claim 1 and therefore include all of the features of claim 1, it is respectfully submitted that Scott does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 1.

As regards to claim 13, which has been amended herein without prejudice to include features essentially analogous to features included in claim 1, it is respectfully submitted that Scott does not anticipate claim 13 for at least the same reasons given above in support of the patentability of claim 1.

As regards to claim 15, which depends from claim 13 and therefore includes all of the features of claim 13, it is respectfully submitted that Scott does not anticipate this dependent claim for at the same reasons given above in support of claim 13.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 2 Under 35 U.S.C. § 103(a)

Claim 2 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Scott and information the Office Action asserts to be “old and well known.” Applicants respectfully submit that the combination of Scott and the asserted “old and well known” information does not render unpatentable claim 2 for the following reasons.

Claim 2 depends from claim 1 and therefore includes all of the features of claim 1. As more fully set forth above, Scott does not disclose, or even suggest, all of the features of claim 1. Furthermore, the Office Action’s assertions that “it is old and well known to cut metallic components that are cast” do not cure the above-noted deficiencies of Scott. That is, the assertions by the Office do not disclose, or even suggest, the features of claim 1 not disclosed or suggested by Scott.

Since the combination of Scott and the allegedly “old and well known” information asserted by the Office action fails to disclose, or even suggest, all of the features of claim 1, as more fully set forth above, it is respectfully submitted that the combination of Scott and these assertions by the Office do not render unpatentable claim 2, which depends from claim 1.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

VI. New Claim 18

New claim 18 has been added herein. It is respectfully submitted that new claim 18 adds no new matter and is fully supported by the present application,

including the Specification. Since claim 18 ultimately depends from claim 1, it is respectfully submitted that new claim 18 is patentable over the references relied upon for at least the same reasons more fully set forth above in support of the patentability of claim 1.

VII. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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